UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,411	09/19/2003	John Aram Safa	FORR 2793	1507

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SMITH-HILL AND BEDELL, P.C.
16100 NW CORNELL ROAD, SUITE 220
BEAVERTON, OR 97006

EXAMINER
PATEL, NIRAV B

ART UNIT	PAPER NUMBER
2135	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/666,411	SAFA, JOHN ARAM
	Examiner	Art Unit	
	Nirav Patel	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/29/03*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1. This action is in response to the application filed on 09/19/2003.

2. Claims 1-40 are under examination.

Claim Objections

3. Claims 3, 4, 15, 16, 36 and 37 are objected to because of the following informalities:

Claim 3 recites the limitation **"the encrypted code"**, is objected for lacking proper antecedent basis.

Claims 4, 15, 16, 36 and 37 encompass limitations that are similar to limitations of claim 3. Thus, they are objected with the same rationale applied against claim 3 above.

Claims 4, 37 recite the limitation **"the other variable"**, is objected for lacking proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8, 11, 12 and 13-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A software protection arrangement claim 1 for protecting software is comprised of multiple modules. In accordance with page 12 [paragraph 0067] of applicant's specification, modules are software modules. As such, the claimed system must include hardware or physical transformation necessary to realize any of the functionality of the claimed modules and produce a useful, concrete and tangible result. **Absent recitation of such hardware or physical transformation as part of the claimed arrangements, it is considered non-statutory.**

Claims 2-8 and 11 depend on claim 1, therefore they are rejected with the same rationale applied against claim 1 above.

Claim 12 has limitation that are similar to those of claim 1, thus they are rejected with the same rationale applied against claim 1 above.

Claims 13-20 depend on claim 12, therefore they are rejected with the same rationale applied against claim 12 above.

Claim 21 has limitation that are similar to those of claim 1, thus they are rejected with the same rationale applied against claim 1 above.

Claims 22-24 depend on claim 21, therefore they are rejected with the same rationale applied against claim 21 above.

Claims 25 and 26 have limitation that are similar to those of claim 1, thus they are rejected with the same rationale applied against claim 1 above.

Claim 27 recites " A carrier medium for software which...". In accordance with page 4 [paragraph 0027] of applicant's specification, the medium is a transmission medium on

which the software is carried by a propagating signal. **However, the signal is non-tangible subject matter. Therefore, the claim is rendered as non-statutory.**

Claim 28 depend on claim 27, therefore they are rejected with the same rationale applied against claim 27 above.

Claims 29, 31, 32, 33 have limitation that are similar to those of claim 27, thus they are rejected with the same rationale applied against claim 1 above.

Claim 30 depend on claim 29, therefore they are rejected with the same rationale applied against claim 29 above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1, 6, 8-12, 21, 18-21, 25-34 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes (US Pub. No. 2001/0044782).

As per claim 1, Hughes teaches:

identifying means operable to create an identifier which characterises the device on which the protected software is to be run [paragraph 0036]; authorisation means operable to receive an identifier created by the identifying means to execute a predetermined function on a received identifier to form a derived identifier [paragraph 0040, 0054 lines6-15], execution of the predetermined function being conditional upon verification of a condition required for authorisation of the use of the software [paragraph 0054 lines 6-15, 0055]; and the arrangement further comprising enabling means operable to enable execution of the protected software only when in receipt of an enabling identifier from the authorisation means, the derived identifier serving as an enabling identifier in the event that the derived identifier has been derived by the predetermined function from the identifier of the device on which the protected software is to be run [paragraph 0041-0043].

As per claim 6, the rejection of claim 1 is incorporated and Hughes teaches

the identifier is derived from information which identifies hardware and/or software present at the device [paragraph 0036].

As per claim 8, the rejection of claim 1 is incorporated and Hughes teaches:

the identifying means is operable to create an identifier as aforesaid on each occasion protected software is to run on the device [Fig. 4, paragraph 0042 lines 6-9].

As per claim 9, the rejection of claim 1 is incorporated and Hughes teaches:

the identifying means transmits identifiers to the authorisation means, over the wireless

network [Fig. 2, paragraph 0026 lines 13-16].

As per claim 10, the rejection of claim 1 is incorporated and Hughes teaches:

the authorisation means is operable to transmit derived identifiers to the enabling

means by means of the wireless network [Fig. 2, paragraph 0026 lines 13-16].

As per claim 11, the rejection of claim 1 is incorporated and Hughes teaches:

the enabling means and/or the identifying means are provided by software elements

associated with the protected software [Fig. 3, paragraph 0036 lines 1-3].

As per claim 12, Hughes teaches:

identifying means operable to create an identifier which characterises the device on

which the protected software is to be run [paragraph 0036]; enabling means operable to

receive a derived identifier derived by authorisation means from the identifier created by

the identifying means[Fig. 2, paragraph 0040, 0041 lines 1-3], and the enabling means

being further operable to enable execution of the software only when in receipt of an

enabling identifier, the derived identifier serving as an enabling identifier in the event

that the derived identifier has been derived by the predetermined function from the

identifier of the device on which the software is to be run [paragraph 0043, 0036].

As per claim 18, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 6. Thus, it is rejected with the same rationale applied against claim 6 above.

As per claim 19, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 8. Thus, it is rejected with the same rationale applied against claim 8 above.

As per claim 20, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 11. Thus, it is rejected with the same rationale applied against claim 11 above.

As per claim 21, Hughes teaches:

authorisation means operable to receive an identifier characterising a device on which protected software is to be run [Fig. 2, paragraph 0054 lines 6-7, 0036], and the authorisation means being operable to execute a predetermined function on a received identifier to form a derived identifier, execution of the predetermined function being conditional upon verification of a condition required for authorisation of the use of the software [paragraph 0040, paragraph 0054 6-15]; and to provide the derived identifier to allow enabling means to enable execution of the software only when in receipt of an enabling identifier which is a derived identifier derived from the identifier of the device on which the software is to be run[paragraph 0041-0043].

As per claim 25, it encompasses limitations that are similar to limitations of claim 1.

Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 26, it encompasses limitations that are similar to limitations of claim 12.

Thus, it is rejected with the same rationale applied against claim 12 above.

As per claim 27, it encompasses limitations that are similar to limitations of claim1.

Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 28, the rejection of claim 1 is incorporated and Hughes teaches the

medium being a memory device or a transmission medium on which the software is

carried by a propagating signal [paragraph 0009 lines 1-3].

As per claim 29, it encompasses limitations that are similar to limitations of claim 12.

Thus, it is rejected with the same rationale applied against claim 12 above.

As per claim 30, the rejection of claim 29 is incorporated and it encompasses limitations

that are similar to limitations of claim 28. Thus, it is rejected with the same rationale

applied against claim 28 above.

As per claim 31, it encompasses limitations that are similar to limitations of claim 1.

Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 32, it encompasses limitations that are similar to limitations of claim 12.

Thus, it is rejected with the same rationale applied against claim 12 above.

As per claim 33, it encompasses limitations that are similar to limitations of claim 1.

Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 34, it encompasses limitations that are similar to limitations of claim 1.

Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 39, the rejection of claim 34 is incorporated and it encompasses limitations

that are similar to limitations of claim 6. Thus, it is rejected with the same rationale

applied against claim 6 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2, 13 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hughes (US Pub. No. 2001/0044782) and in view of Weiler et al (US Patent No.

6,725,205).

As per claim 2, the rejection of claim 1 is incorporated and Hughes teaches applying a

function to the identifier and comparing the identifier with the received identifier and

enabling or disabling execution of the software in accordance with the result of the

comparison [paragraph 0043]. Further, Hughes teaches the identifying means to create

an identifier which characterises the device on which the protected software is to be run

[paragraph 0036].

Hughes doesn't expressively teach, to apply a function to the derived identifier to

recover the identifier from which the derived identifier was derived.

Weiler teaches:

the enabling means is operable to apply a function to the derived identifier to recover

the identifier from which the derived identifier was derived, and to compare the

recovered identifier with the identifier created by the identifying means, and to enable or

disable execution of the software in accordance with the result of the comparison [col. 5

lines 37-47, Fig. 3, 4].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to combine Weiler with Hughes, since one would have been

motivated to provide software security and prevent unauthorized use of the software [Weiler, col. 2 lines 15-16, col. 4 line 10].

As per claim 13, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

As per claim 35, the rejection of claim 34 is incorporated and it encompasses limitations that are similar to limitations of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

7.   Claims 3, 5, 7, 17, 24, 36, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US Pub. No. 2001/0044782) and in view of Yoshida et al (US Patent No. 6,075,862).

As per claim 3, the rejection of claim 1 is incorporated and Hughes doesn't expressively teach the protected software is in encrypted form.

Yoshida teaches:

the protected software is in encrypted form requiring decryption by at least one decryption key for successful execution [col. 5 lines 54-56, col. 6 lines 3-11], the enabling means including decryption means operable to execute a process which

includes decryption of the encrypted code, and to use the derived identifier as a key for

the process [col. 6 lines 3-11, col. 7 lines 43-50].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to combine Yoshida with Hughes, since one would have been

motivated to manage a decryption key for decrypting an encrypted software in a

software distribution system [Yoshida, col. 1 lines 7-9].

As per claim 5, the rejection of claim 1 is incorporated and Yoshida teaches:

the identifier further includes information characterising the protected software, and the

authorisation means is operable to select a confidential decryption key corresponding

with the identified software [Fig. 2, 3, col. 6 lines 28-40, col. 7 lines 43-45].

As per claim 7, the rejection of claim 1 is incorporated and Hughes teaches verifying the

license file request and payment of a license fee [paragraph 0055]. Yoshida teaches the

authorisation means is operable to effect a financial transaction or credit check before

allowing execution of the predetermined function [Fig. 5, col. 7 lines 33-42].

As per claim 17, the rejection of claim 16 is incorporated and it encompasses limitations

that are similar to limitations of claim 2. Thus, it is rejected with the same rationale

applied against claim 2 above.

As per claim 24, the rejection of claim 21 is incorporated and it encompasses limitations that are similar to limitations of claim 7. Thus, it is rejected with the same rationale applied against claim 7 above.

As per claim 36, the rejection of claim 34 is incorporated and it encompasses limitations that are similar to limitations of claim 3. Thus, it is rejected with the same rationale applied against claim 3 above.

As per claim 38, the rejection of claim 34 is incorporated and it encompasses limitations that are similar to limitations of claim 5. Thus, it is rejected with the same rationale applied against claim 5 above.

As per claim 40, the rejection of claim 34 is incorporated and it encompasses limitations that are similar to limitations of claim 7. Thus, it is rejected with the same rationale applied against claim 7 above.

8. Claims 4, 16, 17, 22, 23 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US Pub. No. 2001/0044782) in view of Mittal et al (US Patent No. 6,952,770) in view of Yoshida et al (US Patent No. 6,075,862) and in view of Yeung et al (US Patent No. 6,668,246).

As per claim 4, the rejection of claim 1 is incorporated and Hughes teaches executing the predetermined function and the identifier, the derived identifier [paragraph 0040] and, further teaches, enabling means operable to enable execution of the protected software [Fig. 4].

Mittal teaches:

the predetermined function is a function of at least two variables, a received identifier forming one of the variables, and the other variable being a confidential decryption key stored at the authorisation means [col. 3 lines 35-37, 66-67, Fig.2].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Mittal with Hughes, since one would have been motivated to prevent the unauthorized use of the content/software [Mittal, col. 2 lines 15-16].

Yoshida teaches recovering the confidential decryption key for use as a decryption key in decrypting the encrypted code [col. 6 lines 3-11].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yoshida with Hughes and Mittal, since one would have been motivated to manage a decryption key for decrypting an encrypted software in a software distribution system [Yoshida, col. 1 lines 7-9].

Yeung teaches:

execute a second predetermined function of at least two variables, including the identifier and the derived identifier, to recover the confidential decryption key [col. 6 lines 10-20].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to combine Yeung with Hughes, Mittal and Yoshida, since one

would have been motivated to protect the content/software in the content distribution

system [Yeung, col. 1 lines 10-11].

As per claim 16, the rejection of claim 12 is incorporated and it encompasses limitations

that are similar to limitations of claim 4. Thus, it is rejected with the same rationale

applied against claim 4 above.

As per claim 17, the rejection of claim 16 is incorporated and Yoshida teaches:

the identifier further includes information characterising the protected software, and the

authorisation means is operable to select a confidential decryption key corresponding

with the identified software [Fig. 2, 3, col. 6 lines 28-40, col. 7 lines 43-45].

As per claim 22, the rejection of claim 21 is incorporated and it encompasses limitations

that are similar to limitations of claim 4. Thus, it is rejected with the same rationale

applied against claim 4 above.

As per claim 23, the rejection of claim 22 is incorporated and it encompasses limitations

that are similar to limitations of claim 17. Thus, it is rejected with the same rationale

applied against claim 17 above.

As per claim 37, the rejection of claim 34 is incorporated and it encompasses limitations that are similar to limitations of claim 4. Thus, it is rejected with the same rationale applied against claim 4 above.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US Pub. No. 2001/0044782) in view of Weiler et al (US Patent No. 6,725,205) and in view of Yoshida et al (US Patent No. 6,075,862).

As per claim 14, the rejection of claim 13 is incorporated and Hughes doesn't expressively teach the protected software is in encrypted form.

Yoshida teaches:

the protected software is in encrypted form requiring decryption by at least one decryption key for successful execution [col. 5 lines 54-56, col. 6 lines 3-11].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Yoshida with Hughes and Weiler, since one would have been motivated to manage a decryption key for decrypting an encrypted software in a software distribution system [Yoshida, col. 1 lines 7-9].

As per claim 15, the rejection of claim 14 is incorporated and Yoshida teaches:

the enabling means including decryption means operable to execute a process which includes decryption of the encrypted code, and to use the derived identifier as a key for the process [col. 6 lines 3-11, col. 7 lines 43-50].

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirav Patel whose telephone number is 571-272-5936. The examiner can normally be reached on 8 am - 4:30 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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